

REMARKS

Applicant respectfully requests reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 1-34 are *pending*. Claims 1, 33 and 34 are *independent*. Claim 17 has been *canceled* herein without prejudice or disclaimer. Claims 3, 14, 27, 33 and 34 have been *amended*; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Objections

Applicant notes claims 1, 14, 17, 27 and 34 have been objected to due to informalities identified by the Examiner. Applicant has amended claims 3, 14, 27 and 34 to remedy the formalities (Applicant believes that the objection to claim 1 was meant for claim 3 and has amended claim 3 accordingly.) Applicant has canceled claim 17 herein without prejudice or disclaimer. Accordingly, Applicant submits that the Examiner's objections have been overcome.

Claim Rejections - 35 U.S.C. § 101

The Office Action rejected claims 1-32 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states "claims directed to nothing more than abstract ideas (such as mathematical

algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.”

Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Claim 1 is a “computer-implemented method for managing risk related to long term care. . .” and recites “gathering data into the computer system. . .,” and “receiving data into the computer system. . .” As such, Applicant submits the claimed computer system is incorporated and is part of substantive elements of the claim and as such, these elements are not merely extra-solution activity.

Accordingly, Applicant respectfully traverses and submits that the original claims are directed to statutory subject matter and meet the machine or transformation test. Applicant submits claims 2-32, which depend directly or indirectly from independent claim 1, are directed to statutory subject matter for at least the reasons discussed above. Applicant notes the Office Action simply concludes, “[t]he process steps in claims (1-32) are not tied to a machine nor do they execute a transformation. Thus, they are non-statutory.” (Office action page 3) Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claims 1-32 are allegedly directed to non-statutory subject matter and allegedly do not meet either prong of the machine or transformation test. For at least these reasons, Applicant submits that claims 1-32 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claim 17 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has canceled claim 17 herein without prejudice or disclaimer. As such Applicant submits that this ground of rejection has been rendered moot.

Claim Rejections - 35 U.S.C. § 102

The Office Action rejected claims 1-16, 18-27, 30 and 32-34 under 35 U.S.C. § 102(e) as anticipated by Fogel, US Patent No. 6,542,905 (hereinafter "Fogel"). Applicant respectfully traverses the rejection and submits that Fogel does not discuss every element of the noted claims. Although Applicant respectfully traverses the rejection, Applicant has amended independent claim 1 to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices.

Specifically, independent claim 1 recites *inter alia*:

A computer-implemented method for managing risk related to a long term care, the method comprising: . . .

structuring the gathered data and the data relating details of the long term care transaction according to risk quotient criteria;

calculating a risk quotient by referencing the structured data; and

generating a report comprising the risk quotient and at least some of the structured data referenced to calculate the risk quotient.

Applicant submits that Fogel does not discuss or render obvious at least "structuring the gathered data. . . according to risk quotient criteria; calculating a risk quotient. . . ; and generating a report comprising the risk quotient. . . " as recited in independent claim 1.

Examiner asserts that Fogel teaches "structuring the gathered data and the data relating details of the long term care transaction according to risk quotient criteria (column 5, lines 31-39 where the database provides structure); Calculating a risk quotient by referencing the structured data (column 4, lines 18-31); and Generating a report comprising the risk quotient and at least some of the structured data referenced to calculate the risk quotient (column 4, lines 18-31 where a report is generated)." (Office Action page 4) Applicant disagrees.

Instead, Fogel discusses that "healthcare databases contain data about individuals." (Fogel, col. 5 line 31), and goes on to discuss that individuals may be referred to as patients, residents and clients depending on the context (Fogel, col. 5 lines 31-39), but does not discuss "structuring the gathered data and the data relating details of the long term care transaction according to risk quotient criteria" as recited by independent claim 1. Instead of the claimed "risk quotient criteria," Fogel discusses generically "evaluating and scoring the integrity of data" (Fogel, col. 5 line 19) and goes on to discuss that "[a] score is assigned to the portion of data based on the data integrity test, and a report is generated that identifies the score together with suggestions for resolving any data validity problems suggested by the data integrity test." (Fogel, col. 4 lines 27-31). Fogel's data integrity analysis/scoring does not, however, discuss, or render obvious the claimed "calculating a risk quotient. . ." or "generating a report comprising the risk quotient and at least some of the structured data referenced to calculate the risk quotient" as recited by independent claim 1.

Furthermore, although of different claim scope, Applicant submits that independent claims 33-34 and dependent claims 2-16, 18-27, 30 and 32 which depend directly or indirectly from claim 1 are also patentably distinct from Fogel for at least similar reasons to those discussed above identifying deficiencies in Fogel with regard to independent claim 1. Accordingly, for at least these reasons, Applicant requests withdrawal of this ground of rejections.

To anticipate a claim, each and every element of the claim must be provided in the cited reference. As this claim element is not provided for in the reference, Examiner has not met the burden of anticipating the claim and as such, Applicant requests allowance of the claims.

Applicant therefore respectfully requests reconsideration and withdrawal of the Section 102 rejections based upon the Fogel reference.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Fogel, and in further view of Jinnett, U.S. Pre-Grant Publication No 2002/0120477 (hereinafter “Jinnett”). Applicant has canceled claim 17 herein without prejudice or disclaimer. The Office Action also rejected claims 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Fogel, and in further view of Thompson, U.S. Pre-Grant Publication No 2002/0103834 (hereinafter “Thompson”). The Office Action also rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Fogel, and in further view of Guyan, U.S. Pre-Grant Publication No 2003/0145124 (hereinafter “Guyan”).

Applicant respectfully traverses the rejections and submits that the applied references taken alone or in combination, fail to discuss or render obvious every element of the claims and that a *prima facie* case of obviousness has not been established.

Applicant submits that the Examiner has failed to properly set forth the differences in the claims over the applied references. MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and

- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant respectfully submits that for at least the reasons discussed above, identifying several deficiencies in Fogel with regard to independent claim 1, the Examiner has also failed to establish at least the first two requirements for a *prima facie* case of obviousness.

Applicant submits that dependent claims 17, 28, 29 and 31, which depend directly or indirectly from claim 1, are also patentably distinct from the applied references for at least similar reasons to those discussed above identifying deficiencies in Fogel with regard to independent claim 1. Applicant further submits that neither of Thompson's discussion that a "knowledgebank is a computerized repository of lexicons organized and stored in a hierarchical directory" (Thompson, para. 0014) nor Guyan's discussion that "[a] computer program is provided for developing component based software capable of handling insurance-related tasks" (Guyan, para. 0017) remedy the deficiencies of Fogel as discussed above with regard to independent claim 1. Accordingly, for at least these reasons, Applicant requests withdrawal of this ground of rejections.

Conclusion

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-34, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

AUTHORIZATION

The Commissioner is hereby authorized and requested to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-336CP1. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized and requested to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-336CP1.

In the event that a telephone conference would facilitate examination of the application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
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